

Amendment to the Drawing

Please replace original FIG. 3 on sheet 3 with corrected drawing FIG. 3 on replacement sheet 3.

## REMARKS

Upon entry of this Amendment, claims 1 – 3, 5 - 8 and 19 - 41 are pending. Claims 9 – 18 are cancelled without prejudice or disclaimer in response to a restriction requirement by the Examiner and election by the Applicant without traverse. Claim 4 is cancelled to advance prosecution of this case without prejudice or disclaimer. Applicant adds new claims 19 – 41. Claims 1 and 28 are independent. New claims 27 - 41 differ in scope from claims 1 – 3, 5 - 8 and 19 – 26 because new claims 27 - 41 avoid construction under 35 U.S.C. §112 paragraph 6.

Claim 6 stands rejected under 35 U.S.C. §112 as indefinite. Claims 1 – 2 and 6 – 8 stand rejected under 35 U.S.C. §102 as anticipated by U.S. Patent 5,698,815 to *Ragner*.

Claims 3 and 5 stand rejected under 35 U.S.C. §103 as obvious in light of *Ragner* and U.S. Patent 4,388,513 to *Brastow*.

Amendments to the claims traverse the rejections. No new matter is submitted.

### PTO Form 1449

*Brastow* relates to the welding art. To avoid any issue that could possibly arise under 37 CFR §1.56, Applicant now brings to the Examiner's attention the patent documents listed on the PTO Form 1449 filed herewith.

### Drawing

Annotated sheet 3 (so labeled) is filed herewith to identify a change made to FIG. 3. The change corrects a typographical error and finds support, *inter alia*, in paragraph [0044].

### Specification

Applicant amends paragraph [0001] to correct typographical error.

The Examiner has taken the position that Applicant must clarify the voltage level of the stimulus peak voltage (SPV) disclosed, *inter alia*, in paragraph [0046]. Applicant amends paragraph [0046] to more clearly disclose the several implementations that were disclosed in the originally filed paragraph [0046].

#### Rejection under § 112, Second Paragraph

The Examiner has taken the position that claim 6 is indefinite under 35 U.S.C. §112, second paragraph because “an ionization potential” is not known and is hard to estimate. Amendment traverses this rejection. Applicant agrees that an ionization potential depends, *inter alia*, on the nature of the coupling of the stimulus signal and the target; and that “coupling” is not a recited step of the rejected claims.

#### Rejection under § 102

No one reference discloses each and every element of the amended claims.

The Examiner rejects claims 1 – 2 and 6 – 8 as being anticipated under 35 U.S.C. §102(b) by *Ragner*. The Examiner has taken the position that *Ragner* teaches a stimulus signal having a strike stage, a hold stage, and a rest stage. Applicant amends independent claim 1 and files herewith a Declaration under 37 CFR § 1.132 by Robert Stratbucker to traverse the rejections.

*Ragner* teaches a stun bullet having electrodes spaced apart by 3 cm (1.18 inches) (*Ragner* col. 4, l. 1 – 2) or at a distance a few times larger than the diameter of the bullet which is the diameter of a bullet used in a standard fire arm (*Ragner* col. 3, l. 36 – 38; FIGs. 3, 7 – 8, and 11). *Ragner* does not teach or suggest electrodes separation sufficient to deliver a signal that interferes with voluntary control of the target’s skeletal muscles so as to halt voluntary locomotion by the target. A sufficient distance is at least 6 inches. *Declaration of Stratbucker* paragraph 3. Accordingly, *Ragner* does not teach or suggest, *inter alia*, “a strike stage that causes contractions in the skeletal muscles of the target and halts voluntary locomotion by the target” as recited in claim 1.

Withdrawal of the rejections is respectfully requested.

#### Rejection under § 103

The Examiner has taken the position that claims 3 and 5 are obvious under 35 U.S.C. §103(a) in light of *Ragner* cited to supply a strike stage, a hold stage, and a rest stage and *Brastow* cited to supply a first pulse that delivers a first charge and a second pulse that delivers a second charge less than the first charge.

A claimed invention is *prima facie* obvious when (1) one or more references; (2) that were available to the inventor; (3) teach; (4) a suggestion to combine or modify the references:

(5) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. (see treatise by *Donner* "Patent Prosecution" third edition, p. 756 (2003)). Elements (2) and (5) are at issue here.

First the references were not available to the inventor. Second, assuming for the sake of argument that the references were available (which they were not), the proposed combination lacks at least one aspect of the claimed invention not taught or suggested by the references.

These bases are alternatives for dismissing obviousness. In other words, a proper rejection for obviousness will require, *inter alia*, a finding that each reference was available to the inventor; *and* that all elements are made obvious.

A reference is considered "available" when it is reasonably pertinent to the problem facing the inventor. A reference is reasonably pertinent when it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. If a reference is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. *In re Clay*, 23 USPQ 2d 1058, 1060-1061 (Fed. Cir 1992). When a reference is reasonably pertinent to the inventor's problem, the reference is considered to be within the analogous art. Teachings about devices that seem to have very similar functions have been ruled as not within the analogous art. *Wang Laboratories v. Toshiba*, 26 USPQ 1767 (Fed. Cir. 1993) (Memories as claimed were designated to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. In contrast, the reference related to a memory circuit for a larger, more costly industrial controller. These differences make the reference not reasonably pertinent and therefore not analogous art.). Differences that are in some ways related to the problem confronting the inventor are valid basis for concluding that the reference is not available and the combination proposed by the Examiner is improper.

The Examiner has taken the position that *Brastow* is analogous art because *Brastow* "has the same problem solving area, namely treating the matter with pulses of variable amplitude applied in two pulse trains" and that "it would have been obvious . . . to have modified the *Ragner* solution."

*Brastow*, U.S. Patent 6,204,476 to *Reynolds*, and U.S. Patent 3,376,470 to *Stone* were not "available to the inventor" and are not analogous art because the statement of a solution, as

posited by the Examiner, is not a statement of the problem confronting the inventor. A reference directed to a different purpose (problem sought to be solved) is not analogous art.

The Applicant sought to halt locomotion by a target in a manner that uses less power and reduces health risk to the target. *Brastow* sought to increase welded joint strength between similar or dissimilar metals without marring the surface (*Brastow* col. 1, l. 26 – 34; col. 3, l. 9 – 14). *Reynolds* sought to simplify the user interface of a multi-function spray welder using low voltage AC, so that unskilled operators could not select undesirable or invalid welding settings (*Reynolds* col. 2, l. 11 – 25). *Stone* sought to reduce the cost and power requirements of a DC welding arc starter, so that the welding arc can be started and maintained (*Stone* col. 1, l. 32 – 42). A person of ordinary skill in the art of electronic weapons would have no reason to go looking at how to increase joint strength, reduce surface marring, setting valid welding parameters, or starting and maintaining a DC welding arc. Because the problem sought to be solved by the Applicant is so significantly different from the problems sought to be solved by the references, *Brastow*, *Reynolds*, and *Stone* do not meet the standard for being “available to the inventor” and are not analogous art. The rejections are traversed.

The Examiner further fails to make a *prima facie* case of obviousness because the combination of *Ragner*, *Brastow*, *Reynolds*, and *Stone* do not provide each and every limitation of the invention. As set forth above, *Ragner* does not teach or suggest at least “a strike stage that causes contractions in the skeletal muscles of the target and halts voluntary locomotion by the target” as recited by claim 1. *Ragner*, *Brastow*, *Reynolds*, *Stone*, or any combination thereof does not teach or suggest, *inter alia*, “a strike stage that causes contractions in the skeletal muscles of the target and halts voluntary locomotion by the target.” Because dependent claims 3 and 5 include every element of claim 1, claims 3 and 5 cannot be made obvious by a combination that omits an element of claim 1. Accordingly, the combination of *Ragner*, *Brastow*, *Reynolds*, *Stone*, or any combination thereof does not teach or suggest all elements of the claimed invention.

Finally, there is no motivation to make the combination proposed by the Examiner. For any one of the several reasons stated above, the rejections are not supported. The rejections are traversed.

## Conclusion

Reconsideration is respectfully requested. Applicant believes the case is in condition for allowance and respectfully requests allowance of the pending claims.

The Examiner is invited to telephone the undersigned at the telephone number listed below if it would in any way advance prosecution of this case.

Respectfully submitted,

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